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12 MICROSOFT CORPORATION

13 UNITED STATES DISTRICT COURT  
14 NORTHERN DISTRICT OF CALIFORNIA  
15 OAKLAND DIVISION

16 INTERTRUST TECHNOLOGIES  
CORPORATION, a Delaware corporation,

17 Plaintiff,

18 v.

19 MICROSOFT CORPORATION, a  
Washington corporation,

20 Defendant.

21 MICROSOFT CORPORATION, a  
Washington corporation,

22 Counterclaimant,

23 v.

24 INTERTRUST TECHNOLOGIES  
CORPORATION, a Delaware corporation,  
25 Counter Claim-Defendant.  
26

CASE NO. C01-1640 SBA

**MICROSOFT CORPORATION'S  
ANSWER AND COUNTERCLAIMS TO  
INTERTRUST'S THIRD AMENDED  
COMPLAINT; JURY DEMAND**

1 Defendant Microsoft Corporation ("Microsoft") answers the Third Amended  
2 Complaint of InterTrust Technologies Corporation ("InterTrust") as follows:

3 1. Microsoft admits that the Third Amended Complaint purports to state a  
4 cause of action under the patent laws of the United States, 35 United States Code, §§ 271 and  
5 281. Microsoft denies that it has infringed or now infringes the patents asserted against Microsoft  
6 in the Third Amended Complaint. Microsoft denies any and all remaining allegations of  
7 paragraph 1 of the Third Amended Complaint.

8 2. Microsoft admits that the Third Amended Complaint purports to state a  
9 cause of action over which this Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and  
10 1338(a).

11 3. Microsoft admits, for purposes of this action only, that venue is proper in  
12 this judicial district. Microsoft denies any and all remaining allegations of paragraph 3 of the  
13 Third Amended Complaint.

14 4. On information and belief, Microsoft admits the allegations of paragraph 4  
15 of the Third Amended Complaint.

16 5. Microsoft admits the allegations of paragraph 5 of the Third Amended  
17 Complaint.

18 6. Microsoft admits, for purposes of this action only, that it transacts business  
19 in this judicial district. Microsoft denies any and all remaining allegations of paragraph 6 of the  
20 Third Amended Complaint.

21 7. Microsoft admits that on its face the title page of U.S. Patent No. 6,185,683  
22 B1 ("the '683 Patent") states that it was issued February 6, 2001, is entitled "Trusted and secure  
23 techniques, systems and methods for item delivery and execution," and lists "InterTrust  
24 Technologies Corp." as the assignee. Microsoft denies that the '683 Patent was duly and lawfully  
25 issued. Microsoft further denies any and all remaining allegations of paragraph 7 of the Third  
26 Amended Complaint.

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1                   8.     Microsoft admits that on its face the title page of U.S. Patent No. 6,253,193  
2 B1 ("the '193 Patent") states that it was issued June 26, 2001, is entitled "Systems and methods  
3 for the secure transaction management and electronic rights protection," and lists "InterTrust  
4 Technologies Corporation" as the assignee. Microsoft denies that the '193 Patent was duly and  
5 lawfully issued. Microsoft further denies any and all remaining allegations of paragraph 8 of the  
6 Third Amended Complaint.

7                   9.     Microsoft admits that on its face the title page of U.S. Patent No. 5,940,504  
8 ("the '504 Patent") states that it was issued August 17, 1999, and is entitled "Licensing  
9 management system and method in which datagrams including an address of a licensee and  
10 indicative of use of a licensed product are sent from the licensee's site." Microsoft denies that the  
11 '504 Patent was duly and lawfully issued. Microsoft lacks sufficient information to admit or deny  
12 any and all remaining allegations of paragraph 9 of the Third Amended Complaint.

13                  10.    Microsoft admits that on its face the title page of U.S. Patent No. 5,920,861  
14 ("the '861 Patent") states that it was issued July 6, 1999, is entitled "Techniques for defining  
15 using and manipulating rights management data structures," and lists "InterTrust Technologies  
16 Corp." as the assignee. Microsoft denies that the '861 Patent was duly and lawfully issued.  
17 Microsoft further denies any and all remaining allegations of paragraph 10 of the Third Amended  
18 Complaint.

19                  11.    Microsoft admits that on its face the title page of U.S. Patent No. 5,892,900  
20 ("the '900 Patent") states that it was issued April 6, 1999, is entitled "Systems and methods for  
21 secure transaction management and electronic rights protection," and lists "InterTrust  
22 Technologies Corp." as the assignee. Microsoft denies that the '900 Patent was duly and lawfully  
23 issued. Microsoft further denies any and all remaining allegations of paragraph 11 of the Third  
24 Amended Complaint.

25                  12.    Microsoft admits that on its face the title page of U.S. Patent No. 5,982,891  
26 ("the '891 Patent") states that it was issued November 9, 1999, is entitled "Systems and methods  
27 for secure transaction management and electronic rights protection," and lists "InterTrust  
28 Technologies Corp." as the assignee. Microsoft denies that the '891 Patent was duly and lawfully

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MICROSOFT CORPORATION'S ANSWER AND  
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1 issued. Microsoft further denies any and all remaining allegations of paragraph 12 of the Third  
2 Amended Complaint.

3 13. Microsoft admits that on its face the title page of U.S. Patent No. 5,917,912  
4 ("the '912 Patent") states that it was issued June 29, 1999, is entitled "System and methods for  
5 secure transaction management and electronic rights protection," and lists "InterTrust  
6 Technologies Corp." as the assignee. Microsoft denies that the '912 Patent was duly and lawfully  
7 issued. Microsoft further denies any and all remaining allegations of paragraph 13 of the Third  
8 Amended Complaint.

9 14. Microsoft repeats and reasserts its responses to paragraphs 1-7 of the Third  
10 Amended Complaint, as if fully restated herein.

11 15. Microsoft admits that the Third Amended Complaint purports to state a  
12 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
13 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
14 denies any and all remaining allegations of paragraph 15 of the Third Amended Complaint.

15 16. Microsoft denies any and all allegations of paragraph 16 of the Third  
16 Amended Complaint.

17 17. Microsoft denies any and all allegations of paragraph 17 of the Third  
18 Amended Complaint.

19 18. Microsoft denies any and all allegations of paragraph 18 of the Third  
20 Amended Complaint.

21 ~~19. Microsoft denies any and all allegations of paragraph 19 of the Third~~  
22 Amended Complaint.

23 20. Microsoft denies any and all allegations of paragraph 20 of the Third  
24 Amended Complaint.

25 21. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 8 of the  
26 Third Amended Complaint, as if fully restated herein.

27 22. Microsoft admits that the Third Amended Complaint purports to state a  
28 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now

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1 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
2 denies any and all remaining allegations of paragraph 22 of the Third Amended Complaint.

3 23. Microsoft denies any and all allegations of paragraph 23 of the Third  
4 Amended Complaint.

5 24. Microsoft denies any and all allegations of paragraph 24 of the Third  
6 Amended Complaint.

7 25. Microsoft denies any and all allegations of paragraph 25 of the Third  
8 Amended Complaint.

9 26. Microsoft denies any and all allegations of paragraph 26 of the Third  
10 Amended Complaint.

11 27. Microsoft denies any and all allegations of paragraph 27 of the Third  
12 Amended Complaint.

13 28. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 9 of the  
14 Third Amended Complaint, as if fully restated herein.

15 29. Microsoft admits that the Third Amended Complaint purports to state a  
16 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
17 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
18 denies any and all remaining allegations of paragraph 29 of the Third Amended Complaint.

19 30. Microsoft denies any and all allegations of paragraph 30 of the Third  
20 Amended Complaint.

21 ~~31. Microsoft denies any and all allegations of paragraph 31 of the Third~~  
22 ~~Amended Complaint.~~

23 32. Microsoft denies any and all allegations of paragraph 32 of the Third  
24 Amended Complaint.

25 33. Microsoft denies any and all allegations of paragraph 33 of the Third  
26 Amended Complaint.

27 34. Microsoft denies any and all allegations of paragraph 34 of the Third  
28 Amended Complaint.

1                   35.     Microsoft repeats and reasserts its responses to paragraphs 1-6 and 10 of  
2 the Third Amended Complaint, as if fully restated herein.

3                   36.     Microsoft admits that the Third Amended Complaint purports to state a  
4 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
5 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
6 denies any and all remaining allegations of paragraph 36 of the Third Amended Complaint.

7                   37.     Microsoft denies any and all allegations of paragraph 37 of the Third  
8 Amended Complaint.

9                   38.     Microsoft denies any and all allegations of paragraph 38 of the Third  
10 Amended Complaint.

11                   39.     Microsoft denies any and all allegations of paragraph 39 of the Third  
12 Amended Complaint.

13                   40.     Microsoft denies any and all allegations of paragraph 40 of the Third  
14 Amended Complaint.

15                   41.     Microsoft denies any and all allegations of paragraph 41 of the Third  
16 Amended Complaint.

17                   42.     Microsoft repeats and reasserts its responses to paragraphs 1-6 and 11 of  
18 the Third Amended Complaint, as if fully restated herein.

19                   43.     Microsoft admits that the Third Amended Complaint purports to state a  
20 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
21 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
22 denies any and all remaining allegations of paragraph 43 of the Third Amended Complaint.

23                   44.     Microsoft denies any and all allegations of paragraph 44 of the Third  
24 Amended Complaint.

25                   45.     Microsoft denies any and all allegations of paragraph 45 of the Third  
26 Amended Complaint.

27                   46.     Microsoft denies any and all allegations of paragraph 46 of the Third  
28 Amended Complaint.

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1           47.   Microsoft denies any and all allegations of paragraph 47 of the Third  
2 Amended Complaint.

3           48.   Microsoft denies any and all allegations of paragraph 48 of the Third  
4 Amended Complaint.

5           49.   Microsoft repeats and reasserts its responses to paragraphs 1-6 and 12 of  
6 the Third Amended Complaint, as if fully restated herein.

7           50.   Microsoft admits that the Third Amended Complaint purports to state a  
8 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
9 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
10 denies any and all remaining allegations of paragraph 50 of the Third Amended Complaint.

11           51.   Microsoft denies any and all allegations of paragraph 51 of the Third  
12 Amended Complaint.

13           52.   Microsoft denies any and all allegations of paragraph 52 of the Third  
14 Amended Complaint.

15           53.   Microsoft denies any and all allegations of paragraph 53 of the Third  
16 Amended Complaint.

17           54.   Microsoft denies any and all allegations of paragraph 54 of the Third  
18 Amended Complaint.

19           55.   Microsoft denies any and all allegations of paragraph 55 of the Third  
20 Amended Complaint.

21           56.   Microsoft repeats and reasserts its responses to paragraphs 1-6 and 13 of  
22 the Third Amended Complaint, as if fully restated herein.

23           57.   Microsoft admits that the Third Amended Complaint purports to state a  
24 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
25 infringes the patents asserted against Microsoft in the Third Amended Complaint. Microsoft  
26 denies any and all remaining allegations of paragraph 57 of the Third Amended Complaint.

27           58.   Microsoft denies any and all allegations of paragraph 58 of the Third  
28 Amended Complaint.

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1                   59.     Microsoft denies any and all allegations of paragraph 59 of the Third  
2 Amended Complaint.

3                   60.     Microsoft denies any and all allegations of paragraph 60 of the Third  
4 Amended Complaint.

5                   61.     Microsoft denies any and all allegations of paragraph 61 of the Third  
6 Amended Complaint.

7                   62.     Microsoft denies any and all allegations of paragraph 62 of the Third  
8 Amended Complaint.

9                                   **AFFIRMATIVE AND OTHER DEFENSES**

10                   Further answering the Third Amended Complaint, Microsoft asserts the following  
11 defenses. Microsoft reserves the right to amend its answer with additional defenses as further  
12 information is obtained.

13                                   **First Defense: Noninfringement of the Asserted Patents**

14                   63.     Microsoft has not infringed, contributed to the infringement of, or induced  
15 the infringement of U.S. Patent No. 6,185,683 B1 ("the '683 Patent"), U.S. Patent No. 6,253,193  
16 B1 ("the '193 Patent"), U.S. Patent No. 5,940,504 ("the '504 Patent"), U.S. Patent No. 5,920,861  
17 ("the '861 Patent"), U.S. Patent No. 5,892,900 ("the '900 Patent"), U.S. Patent No. 5,982,891  
18 ("the '891 Patent"), or U.S. Patent No. 5,917,912 ("the '912 Patent"), and is not liable for  
19 infringement thereof.

20                   64.     Any and all Microsoft products or methods that are accused of  
21 infringement have substantial uses that do not infringe and therefore cannot induce or contribute  
22 to the infringement of the '683 Patent, the '193 Patent, the '504 Patent, the '861 Patent, the '900  
23 Patent, the '891 Patent, or the '912 Patent.

24                                   **Second Defense: Invalidity of the Asserted Patents**

25                   65.     On information and belief, the '683 Patent, the '193 Patent, the '504 Patent  
26 the '861 Patent, the '900 Patent, the '891 Patent, and the '912 Patent are invalid for failing to  
27 comply with the provisions of the Patent Laws, Title 35 U.S.C., including without limitation one  
28 or more of 35 U.S.C. §§ 102, 103 and 112.

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1 **Third Defense: Unavailability of Relief**

2 66. On information and belief, Plaintiff has failed to plead and meet the  
3 requirements of 35 U.S.C. § 271(b) and (c) and is not entitled to any alleged damages prior to  
4 providing any actual notice to Microsoft of the '683 Patent, the '193 Patent, the '504 Patent, the  
5 '861 Patent, the '900 Patent, the '891 Patent, or the '912 Patent.

6 **Fourth Defense: Unavailability of Relief**

7 67. On information and belief, Plaintiff has failed to plead and meet the  
8 requirements of 35 U.S.C. § 284 for enhanced damages and is not entitled to any damages prior to  
9 providing any actual notice to Microsoft of the '683 Patent, the '193 Patent, the '504 Patent, the  
10 '861 Patent, the '900 Patent, the '891 Patent, and/or the '912 Patent and any alleged infringement  
11 thereof.

12 **Fifth Defense: Unavailability of Relief**

13 68. On information and belief, Plaintiff has failed to plead and meet the  
14 requirements of 35 U.S.C. § 287, and has otherwise failed to show that it is entitled to any  
15 damages.

16 **Sixth Defense: Prosecution History Estoppel**

17 69. Plaintiff's alleged causes of action for patent infringement are barred under  
18 the doctrine of prosecution history estoppel, and Plaintiff is estopped from claiming that the '683  
19 Patent, the '193 Patent, the '504 Patent, the '861 Patent, the '900 Patent, the '891 Patent, and/or  
20 the '912 Patent covers or includes any accused Microsoft product or method.

21 **Seventh Defense: Dedication to the Public**

22 70. Plaintiff has dedicated to the public all methods, apparatus, and products  
23 disclosed in the '683 Patent, the '193 Patent, the '504 Patent, the '861 Patent, the '900 Patent, the  
24 '891 Patent, and/or the '912 Patent, but not literally claimed therein, and is estopped from  
25 claiming infringement by any such public domain methods, apparatus, and products.

26 **Eighth Defense: Use/Manufacture By/For United States Government**

27 71. To the extent that any accused product has been used or manufactured by  
28 or for the United States, Plaintiff's claims and demands for relief are barred by 28 U.S.C. § 1498.

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1 **Ninth Defense: License**

2 72. To the extent that any of Plaintiff's allegations of infringement are  
3 premised on the alleged use, sale, offer for sale, license or offer of license of products that were  
4 manufactured by or for a licensee of InterTrust and/or provided by or to Microsoft by or to a  
5 licensee of InterTrust, such allegations are barred pursuant to license.

6 **Tenth Defense: Acquiescence**

7 73. Plaintiff has acquiesced in at least a substantial part of the Microsoft  
8 conduct alleged to infringe.

9 **Eleventh Defense: Laches**

10 ~~74.~~ Plaintiff's claims for relief are barred, in whole or in part, by the equitable  
11 doctrine of laches.

12 **Twelfth Defense: Inequitable Conduct**

13 75. The '861 Patent claims are unenforceable due to inequitable conduct,  
14 including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory  
15 Judgment of Unenforceability of the '861 Patent, set forth below.

16 **Thirteenth Defense: Inequitable Conduct**

17 76. The '900 Patent claims are unenforceable due to inequitable conduct,  
18 including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory  
19 Judgment of Unenforceability of the '900 Patent, set forth below.

20 **Fourteenth Defense: Unenforceability**

21 ~~77.~~ The claims of the '891 Patent, the '912 Patent, the '861 Patent, the '683  
22 Patent, the '193 Patent and the '900 Patent are unenforceable due to unclean hands, inequitable  
23 conduct and misuse and illegal extension of the patent right, including those acts and failures to  
24 act set forth in Count XI of Microsoft's Counterclaims, set forth below.

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27 ///

28 ///

1 **COUNTERCLAIMS**

2 **COUNT I - DECLARATORY**  
3 **JUDGMENT OF NONINFRINGEMENT**

4 78. This action arises under the patent laws of the United States, Title 35  
5 U.S.C. §§ 1, *et seq.* This Court has subject matter jurisdiction over this counterclaim under 28  
6 U.S.C. §§ 1338, 2201, and 2202.

7 79. Microsoft Corporation ("Microsoft") is a Washington corporation with its  
8 principal place of business in Redmond, Washington.

9 80. On information and belief, Plaintiff /Counterclaim Defendant InterTrust  
10 Technologies Corporation ("InterTrust") is a Delaware corporation with its principal place of  
11 business in Santa Clara, California.

12 81. InterTrust purports to be the owner of U.S. Patent Nos. 6,185,683 B1 ("the  
13 '683 Patent"), 6,253,193 B1 ("the '193 Patent"), 5,940,504 ("the '504 Patent"), 5,920,861 ("the  
14 '861 Patent"), U.S. Patent No. 5,892,900 ("the '900 Patent"), U.S. Patent No. 5,982,891 ("the  
15 '891 Patent"), and U.S. Patent No. 5,917,912 ("the '912 Patent").

16 82. InterTrust alleges that Microsoft has infringed the '683 Patent, the '193  
17 Patent, the '504 Patent, the '861 Patent, the '900 Patent, the '891 Patent, and the '912 Patent.

18 83. No Microsoft product has infringed, either directly or indirectly, any claim  
19 of the '683 Patent, the '193 Patent, the '504 Patent, the '861 Patent, the '900 Patent, the '891  
20 Patent, or the '912 Patent, and Microsoft is not liable for infringement thereof.

21 84. ~~An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,~~  
22 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to the  
23 infringement or noninfringement of the '683 Patent, the '193 Patent, the '504 Patent, the '861  
24 Patent, the '900 Patent, the '891 Patent, and/or the '912 Patent.

25 **COUNT II - DECLARATORY JUDGMENT**  
26 **OF INVALIDITY OF THE '683 PATENT**

27 85. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if  
28 fully restated herein.

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1           86.    The '683 Patent, and each claim thereof, is invalid for failing to comply  
2 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

3           87.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
4 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
5 whether the claims of the '683 Patent are valid or invalid.

6                           **COUNT III - DECLARATORY JUDGMENT**  
7                           **OF INVALIDITY OF THE '193 PATENT**

8           88.    Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
9 fully restated herein.

10          89.    The '193 Patent, and each claim thereof, is invalid for failing to comply  
11 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

12          90.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
13 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
14 whether the claims of the '193 Patent are valid or invalid.

15                           **COUNT IV - DECLARATORY JUDGMENT**  
16                           **OF INVALIDITY OF THE '504 PATENT**

17          91.    Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
18 fully restated herein.

19          92.    The '504 Patent, and each claim thereof, is invalid for failing to comply  
20 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

21          93.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
22 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
23 whether the claims of the '504 Patent are valid or invalid.

24                           **COUNT V - DECLARATORY JUDGMENT**  
25                           **OF INVALIDITY OF THE '861 PATENT**

26          94.    Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
27 fully restated herein.

1           95.    The '861 Patent, and each claim thereof, is invalid for failing to comply  
2 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

3           96.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
4 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
5 whether the claims of the '861 Patent are valid or invalid.

6                           **COUNT VI - DECLARATORY JUDGMENT**  
7                           **OF INVALIDITY OF THE '900 PATENT**

8           97.    Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
9 fully restated herein.

10           98.    The '900 Patent, and each claim thereof, is invalid for failing to comply  
11 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

12           99.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
13 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
14 whether the claims of the '900 Patent are valid or invalid.

15                           **COUNT VII - DECLARATORY JUDGMENT**  
16                           **OF INVALIDITY OF THE '891 PATENT**

17           100.   Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
18 fully restated herein.

19           101.   The '891 Patent, and each claim thereof, is invalid for failing to comply  
20 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

21           102.   An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
22 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
23 whether the claims of the '891 Patent are valid or invalid.

24                           **COUNT VIII - DECLARATORY JUDGMENT**  
25                           **OF INVALIDITY OF THE '912 PATENT**

26           103.   Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
27 fully restated herein.

104. The '912 Patent, and each claim thereof, is invalid for failing to comply with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103, and 112.

105. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202, exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to whether the claims of the '912 Patent are valid or invalid.

**COUNT IX - DECLARATORY JUDGMENT  
OF UNENFORCEABILITY OF THE '861 PATENT**

106. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if fully restated herein.

107. Claims 1-129 of the '861 Patent application (SN 08/805,804), and claims 1-101 of the '861 Patent, were not and are not entitled to the benefit of any application filing date prior to February 25, 1997, under 35 U.S.C. § 120 or otherwise.

108. "Exhibit A" refers to the document attached as Exhibit A to Microsoft's counterclaims filed in response to InterTrust's Second Amended Complaint (namely, a reprint of an article entitled "DigiBox: A Self-Protecting Container for Information Commerce").

109. On information and belief, the content of pages 2-14 of Exhibit A was presented at a public conference in the United States in July 1995.

110. "Exhibit B" refers to the document attached as Exhibit B to Microsoft's counterclaims filed in response to InterTrust's Second Amended Complaint (namely, a copy of a page from an International Application published under the Patent Cooperation Treaty (PCT), bearing International Publication Number WO 96/27155).

111. On information and belief, International Application WO 96/27155 has, at all times since its filing date, been owned and controlled by InterTrust or its predecessors in interest.

112. International Application WO 96/27155 (hereafter "the WO 96/27155 (PCT) publication") was published on September 6, 1996.

113. United States Patent No. 5,910,987 ("the '987 Patent") issued on June 8, 1999, from a continuation of an application filed on February 13, 1995.

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COUNTERCLAIMS TO INTERTRUST'S THIRD AMENDED  
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1                   114. The Sibert article is prior art to claims 1-129 of the '861 Patent application  
2 (SN 08/805,804).  
3                   115. The Sibert article is prior art to claims 1-101 of the '861 Patent under 35  
4 U.S.C. §§ 102(b).  
5                   116. The WO 96/27155 (PCT) publication is prior art to claims 1-129 of the  
6 '861 Patent application (SN 08/805,804).  
7                   117. The WO 96/27155 (PCT) publication is prior art to claims 1-101 of the  
8 '861 Patent under 35 U.S.C. §§ 102(a).  
9                   118. The '987 Patent is prior art to claims 29-129 of the '861 Patent application  
10 (SN 08/805,804).  
11                   119. The '987 Patent is prior art to claims 1-101 of the '861 Patent, under 35  
12 U.S.C. §§ 102(e).  
13                   120. The Sibert article was material to the patentability of claim 1 of the '861  
14 Patent application (SN 08/805,804).  
15                   121. The Sibert article was material to the patentability of claims 2-129 of the  
16 '861 Patent application (SN 08/805,804).  
17                   122. The WO 96/27155 (PCT) publication was material to the patentability of  
18 claim 1 of the '861 Patent application (SN 08/805,804).  
19                   123. The WO 96/27155 (PCT) publication was material to the patentability of  
20 claims 2-129 of the '861 Patent application (SN 08/805,804).  
21                   124. The '987 Patent was material to the patentability of claims 29-129 of the  
22 '861 Patent application (SN 08/805,804).  
23                   125. One or more of the '861 Patent applicants knew, while the '861 Patent  
24 application (SN 08/805,804) was pending, of the July 1995 publication of the Sibert article.  
25                   126. On information and belief, one or more of the '861 Patent applicants knew,  
26 while the '861 Patent application (SN 08/805,804) was pending, of the September 1996  
27 publication of the WO 96/27155 (PCT) publication.

1           127. One or more of the '861 Patent applicants knew, while the '861 Patent  
2 application (SN 08/805,804) was pending, of the June 8, 1999 issuance of the '987 Patent.

3           128. On information and belief, one or more of the attorneys who prosecuted or  
4 assisted in prosecuting the '861 Patent application (SN 08/805,804) knew, while that application  
5 was pending, of the July 1995 publication of the Sibert article.

6           129. One or more of the attorneys who prosecuted or assisted in prosecuting the  
7 '861 Patent application (SN 08/805,804) knew, while that application was pending, of the  
8 September 1996 publication of the WO 96/27155 (PCT) publication.

9           130. One or more of the attorneys who prosecuted or assisted in prosecuting the  
10 '861 Patent application (SN 08/805,804) knew, while that application was pending, of the June 8,  
11 1999 issuance of the '987 Patent.

12           131. The applicants for the '861 Patent did not cite the Sibert article as prior art  
13 to any of claims 1-129 of the '861 Patent application (SN 08/805,804).

14           132. The applicants for the '861 Patent did not cite the WO 96/27155 (PCT)  
15 publication to the Patent Office as prior art to any of claims 1-129 of the '861 Patent application  
16 (SN 08/805,804).

17           133. The applicants for the '861 Patent did not cite the '987 Patent to the Patent  
18 Office as prior art to any of claims 1-129 of the '861 Patent application (SN 08/805,804).

19           134. The applicants for the '861 Patent did not cite to the Patent Office as prior  
20 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having  
21 the same or substantially the same disclosure as the Sibert article.

22           135. The applicants for the '861 Patent did not cite to the Patent Office as prior  
23 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having  
24 the same or substantially the same disclosure as the WO 96/27155 (PCT) publication.

25           136. The applicants for the '861 Patent did not cite to the Patent Office as prior  
26 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having  
27 the same or substantially the same disclosure as the '987 Patent.

28



1           137. The Sibert article is not merely cumulative over any reference cited as prior  
2 art during the prosecution of the '861 Patent application (SN 08/805,804).

3           138. The WO 96/27155 (PCT) publication is not merely cumulative over any  
4 reference cited as prior art during the prosecution of the '861 Patent application (SN 08/805,804).

5           139. The '987 Patent is not merely cumulative over any reference cited as prior  
6 art during the prosecution of the '861 Patent application (SN 08/805,804).

7           140. On information and belief, one or more of the '861 Patent applicants  
8 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the  
9 Sibert article disclosed an embodiment of claim 1 of the '861 Patent application (SN 08/805,804).

10           141. InterTrust contends that none of the '861 Patent applicants believed, during  
11 pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the Sibert article  
12 discloses an embodiment of claim 1 of the '861 Patent application (SN 08/805,804).

13           142. On information and belief, one or more of the '861 Patent applicants  
14 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the  
15 WO 96/27155 (PCT) publication disclosed an embodiment of claim 1 of the '861 Patent  
16 application (SN 08/805,804).

17           143. It is InterTrust's contention that none of the '861 Patent applicants  
18 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the  
19 WO 96/27155 (PCT) publication discloses an embodiment of claim 1 of the '861 Patent  
20 application (SN 08/805,804).

21           144. On information and belief, one or more of the '861 Patent applicants  
22 believed, while the '861 Patent application (SN 08/805,804) was pending, that the Sibert article  
23 was material to the patentability of claims 1-129 of the '861 Patent application (SN 08/805,804),  
24 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

25           145. On information and belief, one or more of the '861 Patent applicants  
26 believed, while the '861 Patent application (SN 08/805,804) was pending, that the WO 96/27155  
27 (PCT) publication was material to the patentability of claims 1-129 of the '861 Patent application

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1 (SN 08/805,804), but, with deceptive intent, failed to disclose that reference as prior art to the  
2 Patent Office.

3 146. On information and belief, one or more of the '861 Patent applicants  
4 believed, while the '861 Patent application (SN 08/805,804) was pending, that the '987 Patent  
5 was material to the patentability of claims 29-129 of the '861 Patent application (SN 08/805,804),  
6 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

7 147. The '861 Patent is unenforceable due to the inequitable conduct of the '861  
8 Patent applicants before the Patent and Trademark Office in connection with the '861 Patent  
9 application (SN 08/805,804).

10 148. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
11 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
12 whether the claims of the '861 Patent are enforceable.

13 **COUNT X - DECLARATORY JUDGMENT**  
14 **OF UNENFORCEABILITY OF THE '900 PATENT**

15 149. Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if  
16 fully restated herein.

17 150. The application and issued claims of the '900 Patent were not and are not  
18 entitled to the benefit of any application filing date prior to August 30, 1996, under 35 U.S.C. §  
19 120 or otherwise.

20 151. Microsoft repeats and realleges paragraphs 31-32 of its Counterclaims, as if  
21 fully restated herein.

22 152. The Sibert article is prior art to the application and issued claims of the  
23 '900 Patent under 35 U.S.C. § 102(a), 103.

24 153. The Sibert article was material to the patentability of application and issued  
25 claims of the '900 Patent, including, for example, issued claims 86 and 182.

26 154. One or more of the '900 Patent applicants knew of the July 1995  
27 publication of the Sibert article while the '900 Patent application was pending.

1           155. On information and belief, one or more of the attorneys who prosecuted or  
2 assisted in the prosecution of the '900 Patent application knew of the July 1995 publication of the  
3 Sibert article while the '900 Patent application was pending.

4           156. The applicants for the '900 Patent did not cite the Sibert article to the  
5 Patent Office as prior art to any claims of the '900 Patent application (SN 08/706,206).

6           157. The applicants for the '900 Patent did not cite to the Patent Office as prior  
7 art to any claims of the '900 Patent application (SN 08/706,206) any reference having the same or  
8 substantially the same disclosure as the Sibert article.

9           158. The Sibert article is not merely cumulative over any reference cited as prior  
10 art during the prosecution of the '900 Patent application (SN 08/706,206).

11           159. On information and belief, one or more of the '900 Patent applicants  
12 believed, during pendency of claim 1 of the '900 Patent application (SN 08/706,206), that the  
13 Sibert article disclosed an embodiment of claim 1 of the '900 Patent application (SN 08/706,206).

14           160. On information and belief, one or more of the '900 Patent applicants  
15 believed, while the '900 Patent application (SN 08/706,206) was pending, that the Sibert article  
16 was material to the patentability of various claims of the '900 Patent application (SN 08/706,206),  
17 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

18           161. International Application WO 96/27155 (hereafter "the WO 96/27155  
19 (PCT) publication") was published on September 6, 1996.

20           162. The WO 96/27155 (PCT) publication is prior art to the application and  
21 issued claims of the '900 Patent.

22           163. The WO 96/27155 (PCT) publication was material to the patentability of  
23 various application and issued claims of the '900 Patent, including issued claims 86 and 182.

24           164. On information and belief, one or more of the '900 Patent applicants knew,  
25 while the '900 Patent application (SN 08/706,206) was pending, of the September 1996  
26 publication of the WO 96/27155 (PCT) publication.

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1 165. One or more of the attorneys who prosecuted or assisted in prosecuting the  
2 '900 Patent application (SN 08/706,206) knew, while that application was pending, of the  
3 September 1996 publication of the WO 96/27155 (PCT) publication.

4 166. The applicants for the '900 Patent did not cite the WO 96/27155 (PCT)  
5 publication to the Patent Office as prior art to any claims of '900 Patent application (SN  
6 08/706,206).

7 167. The applicants for the '900 Patent did not cite to the Patent Office as prior  
8 art to any claims of the '900 Patent application (SN 08/706,206) any reference having the same or  
9 substantially the same disclosure as the WO 96/27155 (PCT) publication.

10 168. The WO 96/27155 (PCT) publication is not merely cumulative over any  
11 reference cited as prior art during the prosecution of the '900 Patent application (SN 08/706,206).

12 169. On information and belief, one or more of the '900 Patent applicants  
13 believed, while the '900 Patent application (SN 08/706,206) was pending, that the WO 96/27155  
14 (PCT) publication was material to the patentability of various claims of the '900 Patent  
15 application (SN 08/706,206), but, with deceptive intent, failed to disclose that reference as prior  
16 art to the Patent Office.

17 170. The '900 Patent is unenforceable due to the inequitable conduct of the '900  
18 Patent applicants before the Patent and Trademark Office in connection with the '900 Patent  
19 application (SN 08/706,206).

20 171. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
21 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
22 whether the claims of the '900 Patent are enforceable.

23 **COUNT XI - DECLARATORY JUDGMENT**  
24 **OF UNENFORCEABILITY**

25 172. Microsoft repeats and realleges paragraphs 1-5 and 30-94 of its  
26 Counterclaims, as if fully restated herein.

27 173. The '891 Patent, the '912 Patent, the '683 Patent, the '193 Patent, the '861  
28 Patent, and the '900 Patent are referred to as the Count XI Patents.

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1 182. InterTrust has infringed one or more claims of the '671 Patent, in violation  
2 of at least 35 U.S.C. § 271(a, b, c).

3 183. InterTrust's infringement of the '671 Patent has caused and will continue to  
4 cause Microsoft damage, including irreparable harm for which it has no adequate remedy at law.

5 **COUNT XIII - INFRINGEMENT**  
6 **OF U.S. PATENT NO. 6,256,668**

7 184. Microsoft repeats and realleges paragraphs 2-3 and 100 of its  
8 Counterclaims, as if fully restated herein.

9 185. U.S. Patent No. 6,256,668 B1 ("the '668 Patent") issued to Microsoft  
10 Corporation as the assignee of Benjamin W. Slivka and Jeffrey S. Webber on July 3, 2001.

11 186. A true copy of the '668 Patent is attached as Exhibit D to Microsoft's  
12 counterclaims filed in response to InterTrust's Second Amended Complaint, and is incorporated  
13 herein by reference.

14 187. Microsoft owns all right, title and interest in the '668 Patent.

15 188. InterTrust has had actual notice of the '668 Patent.

16 189. InterTrust has infringed one or more claims of the '668 Patent, in violation  
17 of at least 35 U.S.C. § 271(a, b, c).

18 190. InterTrust's infringement of the '668 Patent has caused and will continue to  
19 cause Microsoft damage, including irreparable harm for which it has no adequate remedy at law.

20 **PRAYER FOR RELIEF**

21 WHEREFORE, Microsoft prays for the following relief:

22 A. The Court enter judgment against InterTrust, and dismiss with prejudice,  
23 any and all claims of the Third Amended Complaint;

24 B. The Court enter judgment declaring that Microsoft has not infringed,  
25 contributed to infringement of, or induced infringement of the '683 Patent;

26 C. The Court enter judgment declaring that Microsoft has not infringed,  
27 contributed to infringement of, or induced infringement of the '193 Patent;

1 D. The Court enter judgment declaring that Microsoft has not infringed,  
2 contributed to infringement of, or induced infringement of the '504 Patent;

3 E. The Court enter judgment declaring that Microsoft has not infringed,  
4 contributed to infringement of, or induced infringement of the '861 Patent;

5 F. The Court enter judgment declaring that Microsoft has not infringed,  
6 contributed to infringement of, or induced infringement of the '900 Patent;

7 G. The Court enter judgment declaring that Microsoft has not infringed,  
8 contributed to infringement of, or induced infringement of the '891 Patent;

9 H. The Court enter judgment declaring that Microsoft has not infringed,  
10 contributed to infringement of, or induced infringement of the '912 Patent;

11 I. The Court enter judgment declaring that the '683 Patent is invalid;

12 J. The Court enter judgment declaring that the '193 Patent is invalid;

13 K. The Court enter judgment declaring that the '504 Patent is invalid;

14 L. The Court enter judgment declaring that the '861 Patent is invalid;

15 M. The Court enter judgment declaring that the '900 Patent is invalid;

16 N. The Court enter judgment declaring that the '891 Patent is invalid;

17 O. The Court enter judgment declaring that the '912 Patent is invalid;

18 P. The Court enter judgment declaring that the '861 Patent is unenforceable  
19 due to inequitable conduct;

20 Q. The Court enter judgment declaring that the '900 Patent is unenforceable  
21 due to inequitable conduct;

22 R. The Court enter judgment declaring that the '891 Patent, the '912 Patent,  
23 the '683 Patent, the '193 Patent, the '861 Patent and the '900 Patent is unenforceable due to an  
24 abuse of the patent system, unclean hands, and misuse and illegal extension of the patent right;

25 S. The Court enter judgment that InterTrust has infringed the '671 Patent;

26 T. The Court enter judgment that InterTrust has infringed the '668 Patent;

27 U. The Court enter a permanent injunction prohibiting InterTrust, its officers,  
28 agents, servants, employees, and all persons in active concert or participation with any of them

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1 from infringing the '671 and '668 Patents;

2 V. The Court award damages and attorney fees against InterTrust pursuant to  
3 the provisions of 35 U.S.C §§ 284 and 285;

4 W. The Court award to Microsoft pre-judgment interest and the costs of this  
5 action;

6 X. The Court award to Microsoft its reasonable costs and attorneys' fees; and

7 Y. The Court grant to Microsoft such other and further relief as may be  
8 deemed just and appropriate.

9 **JURY DEMAND**

10 Pursuant to Fed. R. Civ. P. 38(b), Defendant Microsoft Corporation demands a  
11 trial by jury.

12 DATED: November 8, 2001

13 By: 

14 WILLIAM L. ANTHONY  
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1                   **DECLARATION OF SERVICE VIA ELECTRONIC MAIL AND U.S. MAIL**

2                   I am more than eighteen years old and not a party to this action. My place of  
3 employment and business address is 1000 Marsh Road, Menlo Park, California 94025.

4                   On November 8, 2001, I served:

5                   **MICROSOFT CORPORATION'S ANSWER AND COUNTERCLAIMS TO**  
6                   **INTERTRUST'S THIRD AMENDED COMPLAINT; JURY DEMAND**

7 By transmitting a copy of the above-listed document(s) in PDF form via electronic mail Michael  
8 H. Page at mhp@kvn.com, Christopher P. Isaac at chris.isaac@finnegan.com and James E.  
9 Geringer at james.geringer@klarquist.com and also by placing true and correct copies of the  
10 above documents in an envelope addressed to:

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Counterclaimant, MICROSOFT  
CORPORATION

1 and sealing the envelope, affixing adequate first-class postage and depositing it in the U.S. mail  
2 at Menlo Park, California.

3 Executed on November 8, 2001 at Menlo Park, California.

4 I declare under penalty of perjury that the foregoing is true and correct.

5  
6 \_\_\_\_\_  
(SIGNATURE)

7  
8 \_\_\_\_\_  
(PRINT NAME)

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